

DOCKET NO: 282496US8X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JONATHAN J. STONE, ET AL. : EXAMINER: PAN, JOSEPH T
SERIAL NO: 10/006,481 :
FILED: DECEMBER 6, 2001 : GROUP ART UNIT: 2135
FOR: WATERMARKING AND :
TRANSFERRING MATERIAL

RESPONSE TO ELECTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election Requirement dated March 21, 2007, Applicants provisionally elect with traverse Species I, Claims 1-13, 14-16, 20-30, and 73. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicant respectfully traverses this Restriction Requirement for the reason that MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, classes and subclasses without substantial additional effort. Applicants respectfully traverse the Election Requirement on the grounds that a search and examination of the entire application using electronic searching would not place a *serious*

burden on the Examiner, whereas it would clearly be burdensome on Applicants to be required to file, prosecute and maintain separate applications and patents.

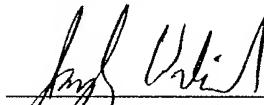
Furthermore, Applicants note that it was not a “serious burden” for the Examiner to conduct a search and examination of all pending claims in preparing the Official Actions mailed August 11, 2005, March 6, 2006, and September 6, 2006. Thus, it is not clear why it would now become a “serious burden” on the Examiner to continue to examine all the pending claims. Moreover, because of the cancellation of some claims, there are now fewer claims pending than when the original application was filed.

As the Examiner has already performed an initial search, and subsequent updated searches, continuing to update the previous searches (using electronic searching methods) would not create a “serious burden.” As the Examiner is already familiar with all the pending claims, Applicants respectfully submit that it would be most efficient to continue prosecution with all the pending claims, rather than begin prosecution again with respect to divisional applications that would need to be filed.

Accordingly, it is respectfully requested that the requirement to elect to a single species be withdrawn, and that a full examination on the merits of Claims 1-16, 20-35, 38-54, 70, 73-98, and 100-125 be conducted.

Respectfully submitted,

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